

Remarks

The present application was filed October 24, 2000 with original claims 1-14. In response to the first Office Action (Paper No. 7) mailed September 5, 2003, Applicant amended claims 1-6 and 12, and 13, cancelled claims 7-11 and 14, and filed new claims 15-24. The Office Action (Paper No. 9) mailed January 23, 2004 rejected claims 1, 2, 4, 12, 15, 17, 20, and 24 and objected to claims 2, 5, 6, 13, 16, 18, 19, and 21-23. In response, the Applicant has reiterated remarks from the previously filed Amendment, and amended claim 20 solely to more particularly point out and distinctly claim the novel subject matter of the present invention. The amendments to claim 20 are not narrowing in view of a prior art rejection; the prior art rejection is erroneous as a matter of law because the Examiner has not met his burden of providing a prima facie case of obviousness. These remarks and amendments are proper, do not introduce new matter, and place the application in proper condition for reconsideration.

Rejection of Claims Under 35 U.S.C. §103

The Office Action rejected claims 1, 2, 4, 12, 15, 17, and 24 as being obvious over U.S. Patent No. 5,729,718 issued to Au ("Au '718") in view of U.S. Patent No. 5,912,782 issued to Lee ("Lee '782"). This rejection is respectfully traversed.

Claim 1

Au '718 and Lee '782 do not disclose or suggest the recited feature "*determining a radial position offset between a presently active data transducer and a different, target data transducer...said offset comprising a distance extending along a radius of said surfaces....*"

Au '718 and Lee '782 furthermore do not disclose or suggest the recited feature *“using the determined radial position offset distance to schedule a seek operation....”*

The Applicant agrees that “Au fails to specify the calculated distance being the claimed radial positional offset distance between the presently active head and the associated target head.” (Office Action, pg. 3) However, the Applicant respectfully submits that the Examiner’s reliance on Lee '782 in curing the deficient disclosure of Au '718 is misplaced. The portion of Lee '782 on which the Examiner relies discloses the use of a state estimator 316 in a closed-loop servo system in repeatedly calculating the difference between a target position and the estimated position. Lee '782, as well as Au '718, are wholly silent regarding the present invention as claimed in claim 1 wherein the positional offset distance is a determining factor in scheduling a seek operation.

For at least these reasons, the cited references cannot sustain the Section 103 because the Examiner has not met his burden of providing a prima facie case of obviousness; the cited references do not, alone or in combination, disclose or suggest all the features recited by the language of claim 1. Accordingly, the Applicant respectfully submits that the rejection of claim 1 as being obvious over Au '718 in view of Lee '782 is erroneous as a matter of law, and requests withdrawal of the rejection and allowance of claim 1 and the claims depending therefrom.

Claim 12

Au '718 and Lee '782 do not disclose or suggest the cited feature *“means for scheduling a plurality of pending access commands....”* Claim 12 is written in accordance with 35 U.S.C. §112, sixth paragraph. The Applicant has identified the recited “means” element to cover at least the control processor 140 programmed to carry out the routine 192.

This structure accounts for a radial positional offset distance between the presently active head and the associated target head in scheduling a seek operation.

The Examiner is obliged as a matter of law to construe this means element as this structure, and equivalents thereof. See *B. Braun Medical, Inc. v. Abbott Lab.*, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997); *In re Donaldson Co. Inc.*, 26 USPQ2d 1845 (Fed. Cir. 1994)(*en banc*); *In re Dossel*, 42 USPQ2d 1881 (Fed. Cir. 1997); *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, Para. 6*, 65 FR 38510. Failure to do so constitutes reversible error.

When this means element is properly construed, it is clear that Au '718 and Lee '782 fail to disclose this element. As discussed above, Au '718 and Lee '782 are wholly silent regarding determining the radial offset and scheduling a seek operation from determining the offset. For at least these reasons, Au '718 and Lee '782 cannot sustain the Section 103 rejection because the Examiner has not met his burden of providing a prima facie case of obviousness; the cited references do not, alone or in combination, disclose or suggest all the features recited by the language of claim 12. Accordingly, the Applicant respectfully submits that the rejection of claim 12 as being obvious over Au '718 in view of Lee '782 is erroneous as a matter of law, and requests withdrawal of the rejection and allowance of claim 12 and the claims depending therefrom.

Claim 15

Au '718 and Lee '782 do not disclose or suggest the recited feature "*a control circuit which schedules a seek operation...said scheduling based on a corrected seek time determined in relation to a radial positional offset distance between the presently active data transducer and the target data transducer....*"

The Applicant agrees that “Au fails to specify the calculated distance being the claimed radial positional offset distance between the presently active head and the associated target head.” (Office Action, pg. 3) However, the Applicant respectfully submits that the Examiner’s reliance on Lee ‘782 in curing the deficient disclosure of Au ‘718 is misplaced. The portion of Lee ‘782 on which the Examiner relies discloses the use of a state estimator 316 in a closed-loop servo system in repeatedly calculating the difference between a target position and the estimated position. Lee ‘782, as well as Au ‘718, are wholly silent regarding the present invention as claimed in claim 15 wherein the positional offset distance is a determining factor in scheduling a seek operation.

For at least this reason, the cited references cannot sustain the Section 103 because the Examiner has not met his burden of providing a prima facie case of obviousness; the cited references do not, alone or in combination, disclose or suggest all the features recited by the language of claim 15. Accordingly, the Applicant respectfully submits that the rejection of claim 15 as being obvious over Au ‘718 in view of Lee ‘782 is erroneous as a matter of law, and requests withdrawal of the rejection and allowance of claim 15 and the claims depending therefrom.

Claim 20

Au ‘718 and Lee ‘782 do not disclose or suggest the recited feature in the previously presented language “*determining a radial offset distance between nominally aligned first and second data transducers...said distance extending radially along said surfaces....*” Au ‘718 and Lee ‘782 furthermore do not disclose or suggest the recited feature in the previously presented language “*using the determined radial offset distance to schedule a seek operation....*”

The Applicant agrees that “Au fails to specify the calculated distance being the claimed radial positional offset distance between the presently active head and the associated target head.” (Office Action, pg. 3) However, the Applicant respectfully submits that the Examiner’s reliance on Lee ‘782 in curing the deficient disclosure of Au ‘718 is misplaced. The portion of Lee ‘782 on which the Examiner relies discloses the use of a state estimator 316 in a closed-loop servo system in repeatedly calculating the difference between a target position and the estimated position. Lee ‘782, as well as Au ‘718, are wholly silent regarding the present invention as claimed in claim 1 wherein the positional offset distance is a determining factor in scheduling a seek operation.

For at least these reasons, the cited references cannot sustain the Section 103 because the Examiner has not met his burden of providing a prima facie case of obviousness; the cited references do not, alone or in combination, disclose or suggest all the features recited by the language of claim 20.

The Applicant is at a loss in understanding the Examiner’s basis for this and all other rejections, as discussed above. Nevertheless, the Applicant has amended claim 20 solely for the purpose of facilitating prosecution on the merits by attempting to more particularly point out and distinctly claim that which the Applicant believes to be patentable subject matter. This amendment is not narrowing in view of a prior art rejection; the Section 103 rejection is erroneous as a matter of law because the Examiner has failed to provide a bona fide prima facie case of obviousness.

Particularly, amended claim 20 attempts to more particularly point out and distinctly claim that the offset distance extends “*between the transducers*,” that the offset distance is used to “*schedule a seek operation from a plurality of operations*,” and that the scheduled

seek operation is operative in *“moving the second data transducer to a destination data storage cylinder different than the first data storage cylinder.”*

The Applicant respectfully submits that the rejection of claim 20 as being obvious over Au '718 in view of Lee '782 is erroneous as a matter of law, but that the amendments to claim 20 obviate the rejection by more particularly pointing out and distinctly claiming the novel subject matter of the present invention. Reconsideration and withdrawal of the rejection and allowance of claim 20 and the claims depending therefrom are respectfully requested.

Allowable Subject Matter

The Applicant gratefully acknowledges the indication of allowable subject matter in claims 5, 6, 13, 16, 18-19, and 21-23. For the reasons above, however, the broader independent claims from which these claims depend are allowable. As such, the Applicant has elected not to place these dependent claims in independent form.

Request for Telephone Interview

The Applicant acknowledges there is no basis in right, but that the Examiner has discretion to grant a telephone interview in this case. The Applicant hereby requests, with requisite interview request form filed herewith, a telephone interview at such time when the Examiner has reviewed this Amendment and before such time when the Examiner responds with an action on the merits. The interview is necessary to clarify potential unresolved issues in the Examiner's construction of the offset distance and the scheduling of a seek operation based on the offset distance. The Applicant is at a complete loss as to how the

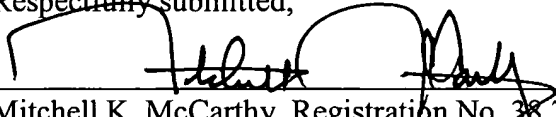
Examiner's claim construction is reasonable in view of the cited references. The interview would be helpful in furthering prosecution on the merits where Applicant believes the Final Office Action is nonresponsive to the Applicant's previous remarks concerning these recited claim features.

Conclusion

The Applicant respectfully requests reconsideration and allowance of all of the claims pending in the application. This is a complete response to the Office Action (Paper No. 9) mailed January 23, 2004. Should any questions arise concerning this response, the Examiner is invited to contact the below signed attorney.

Respectfully submitted,

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